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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,077	05/08/2007	Yoshio Miki	08178.0031	3057
7590 08/12/2010 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER 1300 I STREET, N.W. WASHINGTON, DC 20005				
EXAMINER				
JOHANNSEN, DIANA B				
ART UNIT		PAPER NUMBER		
1634				
MAIL DATE		DELIVERY MODE		
08/12/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,077

Applicant(s)

MIKI ET AL.

Examiner

Diana B. Johannsen

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1 and 4-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: _____

Election/Restrictions

1. This action is responsive to the Amendments and Reply filed June 17, 2010, in which applicant has requested that claims 6-9 be reinstated for further prosecution in view of applicant's amendments to claim 6. In view of applicant's amendments, and specifically the amendment of claim 6 such that it is drawn to the method of claim 1 "further comprising" identifying one or more additional polymorphisms in claim 6, the examiner concurs that claim 6 should be rejoined and considered. Additionally, claims 7-9 will also be rejoined if applicant elects the species corresponding to SEQ ID NO: 4, as noted below. Applicant's amendments have necessitated the following supplementary species election requirement. It is noted that applicant's original election of October 28, 2009 remains in effect, and that prosecution of the originally elected species of the polymorphism of SEQ ID NO: 6 will continue. The species elected in response to this supplementary requirement will be considered in combination with the previously elected species of the polymorphism in SEQ ID NO: 6 (as set forth in claims 6-9 as amended June 17, 2010). Rejoinder will apply as indicated below.

Supplementary species election

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Each of the 5 different CYP2C8 polymorphisms set forth in claim 6 constitutes a separate species. It is noted that, **at applicant's discretion**, applicant may choose to elect one combination of the polymorphisms of claim 6 in lieu of a single polymorphism.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim. Currently, the following claim(s) are generic: claim 1 is generic with regard to all species of claim 6, and claim 6 is a Markush type generic claim.

The claims are deemed to correspond to the species listed above in the following manner:

Claim 6 embraces all species.

Claims 7-9 correspond to the "genetic polymorphism at the 11th nucleotide of the sequence defined by SEQ ID NO: 4 in CYP2C8" in claim 6 (i.e., the 4th of the 5 species recited in claim 6).

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons. Unity of invention among alternatives of a Markush group exists if the alternatives are "of a similar nature"

(see MPEP 1850 and 1893.03(d)). Alternatives may be considered "of a similar nature" if they (A) have a common property or activity; AND (b) share a significant structural element OR belong to a recognized class of compounds; it is noted that alternatives are only considered members of a recognized class if there is an expectation that they could be substituted one for the other to achieve the same result. In the present case, the alternatives embraced by the claims do have a common property or activity in that the polymorphisms and combinations thereof are each disclosed as having a relationship to granulocytopenia risk. However, each polymorphism (and each combination thereof) is characterized by a different sequence/structure. Further, a substitution of one polymorphism for the other (or one combination for the other) would result in the detection of entirely different sequences/structures; a skilled artisan would not expect to be able to, e.g., detect one polymorphism as an indicator of the presence of the other in the present case. Thus, the various species embraced by the claims lack a special technical feature under PCT Rule 13.2, and unity of invention is lacking.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be

presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 571/272-0744. The examiner can normally be reached on Monday-Friday, 8:30 am-2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Nguyen can be reached at 571/272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diana B. Johannsen/
Primary Examiner, Art Unit 1634